

## **REMARKS**

### **Status of the Application**

Claims 1-38 are pending in the present application. By this amendment, claims 1, 36, and 37 have been amended, new claim 39 has been added, and no claims have been cancelled. Thus, claims 1-39 are currently at issue. Applicants note that the amendment to claim 36 was done for antecedent basis purposes, and does not affect the scope of the claim.

### **Interview Summary**

The Examiner conducted an interview with Applicants' attorneys on January 5, 2006. In the interview, the Examiner's rejections with respect to claims 14, 16, 36, and 37 were discussed, with reference to the Warden, Strange, and Reidinger references. Also, Supervisory Examiner Mar conducted another interview with Applicants' attorney on January 12, 2006. In the interview, withdrawal of the finality of the previous Office Action was discussed. Applicants thank Examiner Ngo and Supervisory Examiner Mar for their time in conducting interviews with Applicants' attorneys.

### **Objections to the Drawings**

In paragraph 1 of the Office Action, the Examiner objected to the drawings as failing to comply with 37 C.F.R. §1.84(p)(4). The Examiner stated that reference character "24" has been used to designate both the straw opening and the game piece in the specification. Applicants have amended the specification to address the Examiner's objection, and Applicants respectfully request the Examiner to withdraw the drawing objection.

### **Claim Rejections Under 35 U.S.C. § 102**

#### **Rejections over Strange**

In paragraph 4 of the Office Action, the Examiner rejected claims 1-11 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,056,144, to Strange *et al.* ("Strange"). Applicants respectfully traverse the Examiner's rejection.

In order for a reference to constitute a §102(b) bar to patentability, the reference must disclose each and every element of the claimed invention. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 U.S.P.Q. 781, 789 (Fed. Cir. 1983). It is well-settled law that the burden of establishing a *prima facie* case of anticipation resides with the Patent & Trademark Office. *Ex Parte Skinner*, 2 U.S.P.Q. 2d 1788 (BPAI 1986).

Claim 1, as amended, includes, among other elements, a “central plateau having an outer sidewall, the outer sidewall including a circumferential beveled segment extending along a portion of the outer sidewall ... the circumferential beveled segment angled with respect to the outer sidewall.” Applicants respectfully submit that Strange does not disclose this element of claim 1. Strange discloses a locking lid for a beverage cup that attaches to the cup more securely due to a unique arrangement of protuberances on the inner side of the lid. (See Strange, col. 1, lines 24-55). The lid (10) contains a central dome portion (12) that extends across the major portion of the lid’s overall diameter. (See Strange, col. 2, lines 63-65). Although the structure of the dome (12) of Strange is not generally discussed within the specification, discussion can be made with reference to the Figures.

Strange does not disclose a circumferential beveled segment extending along a portion of the sidewall that is angled with respect to the sidewall. The depending wall of Strange angles downwardly from the dome (12) around its entire circumference, and does not contain any variation in angle. (See Strange, FIGS. 4-5). The plateau (16) of the present application also contains a circumferential side wall (16-2) depending into a trough (18). (See par. [0019] – [0020], FIGS. 3-4). However, the specification and claims of the present application clearly differentiate between this side wall (16-2) and the beveled segment (16-3). With reference to FIGS. 3-5 of the present application, as well as the language of claim 1, the beveled segment (16-3) is only a portion of this side wall (16-2), and is angled with respect to the rest of the side wall (16-2). Strange discloses no such structure since, as described above, the side wall of Strange contains no variations. Additionally, there is no disclosure in Strange that the dome (12) is adapted to receive a promotional game piece. (See, *e.g.*, Strange, FIGS. 4-5). In fact, there is no discussion or suggestion of any promotional game piece anywhere in Strange. Thus, Strange does not disclose this element of claim 1, and does not anticipate claim 1.

Claims 2-11 depend from claim 1 and contain all the elements of claim 1. Thus, for the reasons set forth above with respect to claim 1, Strange does not anticipate claims 2-11.

#### Rejections over Reidinger

In paragraph 5 of the Office Action, the Examiner rejected claims 14 and 36 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,311,860, to Reidinger *et al.* (“Reidinger”). Applicants respectfully traverse the Examiner’s rejections.

Claim 14 includes, among other elements, “a promotional game piece affixed to said lid so as to cover said recessed well in spaced relationship to said bottom wall thereof.” Applicants respectfully submit that Reidinger does not disclose this element of claim 14. Reidinger discloses a lid (30) that contains a recessed well (44) configured to receive a game piece (54), which is then covered by a sealing member (60) to retain the game piece therein. (See Reidinger, col. 4, lines 45-47; col. 5, lines 17-20).

Reidinger does not disclose a game piece that is either affixed to the lid or that covers the recessed well. On the contrary, the game piece (54) in Reidinger lies flat within the recessed well (44) and is contained therein by the presence of the sealing member (60). (Reidinger, col. 4, lines 45-51; col. 5, lines 17-24). Therefore, Reidinger discloses the opposite of the claimed structure, *i.e.*, that the game piece is received within the well, rather than covering the well. The Examiner asserts the sealing member (60) of Reidinger is a “game piece.” Applicants vigorously object to this unreasonable interpretation by the Examiner. Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003). The sealing member (60) of Reidinger is not a game piece, and one of ordinary skill in the art would recognize the difference between these two recognizable structures. The Examiner’s interpretation is particularly unreasonable because Reidinger teaches that the sealing member (60) (which the Examiner asserts is a “game piece”) functions to cover the actual game piece (54) lying in the well (44). (Reidinger, col. 4, lines 45-51; col. 5, lines 17-24). To take the Examiner’s interpretation of Reidinger requires the claim term “game piece” to be stripped of all effective

meaning. In addition, Reidinger is completely void of any suggestion that the sealing member 60 functions as a game piece. Thus, Reidinger does not disclose this element of claim 14 and does not anticipate claim 14.

Claim 36 includes, among other elements, “a promotional game piece affixed to the lid around a periphery of the recessed well in spaced relationship to the bottom wall.” This element is similar to the above-discussed element of claim 14. As stated above, Reidinger does not disclose a game piece affixed to the lid and in spaced relationship to the bottom wall of a recessed well. Further, as stated above, the sealing member (60) of Reidinger is not a “game piece,” and any such interpretation of Reidinger is unreasonable and strips the claim terms of all meaning. Thus, for the reasons stated above with respect to claim 14, Reidinger does not disclose this element of claim 36 and does not anticipate claim 36.

#### Rejections over Nava

In paragraph 6 of the Office Action, the Examiner rejected claims 14-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,196,411, to Nava *et al.* (“Nava”). Applicants respectfully traverse the Examiner’s rejections.

Claim 14 includes, among other elements, “a promotional game piece affixed to said lid so as to cover said recessed well in spaced relationship to said bottom wall thereof.” Applicants respectfully submit that Nava does not disclose this element of claim 14. Nava discloses, in relevant part, a lid or closure (510) including an inner closure member (512) and an outer closure member (514) which cooperate to define a cavity therebetween to hold a compact disc (CD) (516). (Nava, col. 10, lines 20-55; FIGS. 19-21). Nava does not disclose a game piece that is affixed to the lid and that covers the recessed well. The Examiner asserts that the outer member (514) of the lid is a “game piece.” As before, the Examiner’s interpretation is unreasonable because it strips the claim terms of any meaning, and Applicants vigorously object. One skilled in the art would recognize that the outer member (514) of Nava is not a game piece. The outer member (514) is a structural component of the lid (510), effectively constituting half of the lid (510). (See Nava, FIG. 19). Thus, the Examiner’s interpretation of Nava essentially calls the lid

itself a game piece, which Applicants submit is unreasonable. Therefore, Nava does not disclose this element of claim 14 and does not anticipate claim 14.

Claims 15-20 depend from claim 14 and contain all the limitations of claim 14. Thus, for the reasons set forth above with respect to claim 14, Nava does not anticipate claims 15-20.

### **Claim Rejections Under 35 U.S.C. § 103**

#### **Rejections over Strange in view of Reidinger**

In paragraph 8 of the Office Action, the Examiner rejected claims 12-15, 19-22, and 25-35 under 35 U.S.C. § 103(a) as being unpatentable over Strange in view of Reidinger.

Applicants respectfully traverse the Examiner's rejections.

To establish a *prima facie* case of obviousness, all the elements of the claimed invention must be disclosed, taught, or suggested by the prior art. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). It is the burden of the Patent and Trademark Office to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103. *In re Reuter*, 210 U.S.P.Q.2d 249 (CCPA 1981).

Claim 12 expressly incorporates all the elements of claim 1 therein. Accordingly, claim 12 includes, among other elements, a "central plateau having an outer sidewall, the outer sidewall including a circumferential beveled segment extending along a portion of the outer sidewall ... the circumferential beveled segment angled with respect to the outer sidewall." As discussed above with respect to claim 1, Strange does not disclose or suggest this element. Applicants respectfully submit that Reidinger also does not disclose this element. First, Reidinger does not disclose any circumferential beveled segment in a sidewall of the lid, as recited in claim 12. Indeed, the Examiner does not assert that Reidinger discloses or suggests such a structure. Thus, neither Strange nor Reidinger, alone or in combination, discloses or suggests this element of claim 12, and the Examiner has not presented a *prima facie* case of obviousness with respect to claim 12.

Claim 12, via claim 1, also includes, among other elements, "the outer sidewall including a circumferential beveled segment ... over which a tab of the game piece may extend to thereby

facilitate grasping of the game piece tab by a customer.” As discussed above, the game piece (54) in Reidinger sits within the recessed well (44) and is covered by a sealing member (60). Therefore, it is impossible for any portion of the game piece (54) to extend over a circumferential beveled segment, even if one were present. Reidinger discloses a different arrangement than that of claim 12, specifically that a game piece (54) is received in a recess in the lid, rather than affixed to a “raised central plateau.” As previously discussed, the sealing member (60) of Reidinger is not a game piece. Further, even if the sealing member (60) were a game piece, the sealing member (60) does not approach the outer sidewall of the lid of Reidinger, and therefore, could not extend over a beveled segment in said sidewall. Thus, for this additional reason, the Examiner has not presented a *prima facie* case of obviousness with respect to claim 12.

Claim 13 depends from claim 12 and contains all the elements of claim 12. Thus, for the reasons set forth above with respect to claim 12, the Examiner has not presented a *prima facie* case of obviousness with respect to claim 13.

Claim 14 contains, among other elements, “a promotional game piece affixed to said lid so as to cover said recessed well in spaced relationship to said bottom wall thereof.” As discussed above with respect to claim 14, Reidinger does not disclose this element. Applicants also submit that Strange does not disclose this element. As discussed above, Strange does not even disclose or suggest any use of game pieces or similar articles in connection with the disclosed lid. Thus, neither Strange nor Reidinger, alone or in combination, discloses or suggests this element of claim 14, and the Examiner has not presented a *prima facie* case of obviousness with respect to claim 14.

Claims 15, 19-22, and 25-27 depend from claim 14 and contain all the elements of claim 14. Thus, for the reasons set forth above with respect to claim 14, the Examiner has not presented a *prima facie* case of obviousness with respect to claims 15, 19-22, and 25-27.

Claim 28 includes, among other limitations, “affixing a promotional game piece to said annular upper wall such that said game piece covers said recessed well in spaced relationship to said bottom surface thereof.” Applicants respectfully submit that neither Strange nor Reidinger discloses this limitation of claim 28. As discussed above with respect to claim 14, the game

piece (54) disclosed in Reidinger does not cover the recessed well (44). Rather, the game piece (54) is contained within the recessed well (44), which is covered by the sealing member (60). Additionally, because the game piece (54) of Reidinger is contained within the well (44), it cannot be affixed to an upper wall of said well (44). Again, the sealing member (60) of Reidinger is not a game piece. Therefore, Reidinger does not disclose this element of claim 28. As also discussed above, Strange does not disclose or suggest the use of a game piece in connection with the disclosed lid, so Strange does not disclose this element. Thus, neither Strange nor Reidinger, alone or in combination, discloses or suggests this element of claim 28, and the Examiner has not presented a *prima facie* case of obviousness with respect to claim 28.

Claims 29-35 depend from claim 28 and contain all the elements of claim 28. Thus, for the reasons set forth above with respect to claim 28, the Examiner has not presented a *prima facie* case of obviousness with respect to claims 29-35.

#### Rejections over Strange in view of Reidinger and Johnson

In paragraph 9 of the Office Action, the Examiner rejected claims 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Strange in view of Reidinger and further in view of U.S. Patent No. 5,746,312, to Johnson ("Johnson").

Claims 23 and 24 depend from claim 14 and contain all the elements thereof, including, among other things, "a promotional game piece affixed to said lid so as to cover said recessed well in spaced relationship to said bottom wall thereof." As discussed above, neither Reidinger nor Strange discloses or suggests this element. Applicants also submit that Johnson does not disclose this element. Johnson discloses a flexible lid (14) comprised of two layers that seal together to form a cavity for containing a constituent (20) therein. (Johnson, col. 4, lines 10-23). This lid (14) is designed to be removed from the cup (10) so the liquid constituent (26) inside can be accessed. (Johnson, col. 4, lines 59-63). First, Johnson never discloses or suggests that the disclosed lid may be used with a promotional game piece. Further, it does not disclose a recessed well, as recited in the claims, or a game piece affixed to the lid to cover such a well. Indeed, the Examiner does not point to any disclosure of this element in Johnson. Thus, the proposed combination of references does not disclose or suggest this element of claims 23 and

24, and the Examiner has not presented a *prima facie* case of obviousness with respect to claim 23 and 24.

Rejections over Warden in view of Reidinger

In paragraph 10 of the Office Action, the Examiner rejected claims 37 and 38 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,398,843, to Warden et al. (“Warden”), in view of Reidinger. Applicants respectfully traverse the Examiner’s rejections.

Claim 37, as amended, includes, among other elements, “the outer side wall having an indented portion ... the game piece comprising a tab, a portion of the tab extending over the indented portion of the side wall to facilitate grasping of the tab by a user.” Applicants respectfully submit that neither Reidinger nor Warden discloses this element of claim 37.

The outer sidewall of the lid of Reidinger does not contain an indented portion over which a portion of the game piece (54) extends. In fact, the game piece (54) of Reidinger does not even approach the outer sidewall of the lid. (See Reidinger, FIG. 7). As discussed above with respect to claim 12, the game piece (54) in Reidinger sits within the recessed well (44) and is covered by a sealing member (60). Further, even under the Examiner’s interpretation that the sealing member (60) is a game piece, the sealing member (60) of Reidinger does not approach the outer sidewall of the lid. Therefore, it is impossible for any portion of the game piece (54) or the sealing member (60) of Reidinger to extend over an indented portion of the sidewall, even if one were present. Thus, Reidinger does not disclose the above element of claim 37.

Warden discloses a lid (10) having a rim portion (16) and a crown portion (18) extending upward from the rim portion (16). The crown portion (18) has a continuous outer side wall (20) and a circular top (22) that includes a truncated trapezoidal structure (30). The trapezoidal structure (30) on the top wall (22) can be broken away from the rest of the top wall (22) to create a drink-through aperture. (Warden, col. 2, lines 52-68; col. 3, lines 7-15). Claim 37, as amended, refers to an outer sidewall having an indented portion. The outer sidewall (20) of the lid of Warden contains no indented portion. (See Warden, FIG. 1). In fact, Warden expressly teaches that this sidewall (20) is continuous. (Warden, col. 2, line 63). Additionally, as acknowledged by the Examiner, Warden does not discuss a game piece for use in connection



with the lid. Thus, neither Warden nor Reidinger, alone or in combination, discloses or suggests this element of claim 37, and the Examiner has not presented a *prima facie* case of obviousness with respect to claim 37.

Claim 38 depends from claim 37 and contains all the elements of claim 37. Thus, for the reasons set forth above with respect to claim 37, the Examiner has not presented a *prima facie* case of obviousness with respect to claim 38.

#### Motivation to Combine

Additionally, Strange is not properly combinable with Reidinger to form an obviousness rejection, Strange and Reidinger are not properly combinable with Johnson to form an obviousness rejection, and Reidinger is not properly combinable with Warden to form an obviousness rejection. The law is clear that there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the modification suggested by Examiner. “[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Laskowski et. al.*, 10 U.S.P.Q. 2d 1397, 1398, (Fed. Cir. 1989), citing *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). That motivation cannot come from the Applicant’s invention itself. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Thus, unless the references suggest the particular combination of elements themselves, they cannot render Applicant’s invention obvious. *In re Mahurkar Patent Litigation*, 831 F.Supp. 1354, 1374, 28 U.S.P.Q.2d 1801, 1817 (N.D. Ill. 1993). Moreover, it is the burden of the Examiner to show that the prior art relied upon contains such a suggestion or incentive. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

Strange offers no motivation to use its disclosure to modify a lid according to the present invention because Strange is directed toward a completely different problem. As discussed above, Strange is directed entirely toward creating a stronger seal between the lid and the cup. (Strange, col. 1, lines 14-22). In fact, the entire center portion of the lid of Strange is largely ignored in the disclosure, since Strange is concentrated on the edge of the lid, where the sealing is accomplished. None of the central features of the lid are even assigned reference characters in

the disclosure of Strange, and are referred to generically as the “dome” (12). (Strange, col. 2, lines 63-67 and FIG. 3). Finally, Strange does not disclose or suggest any use of a game piece or any similar article in connection with the disclosed lid. Thus, there would be no motivation for one skilled in the art to look to Strange or use the teachings of Strange to modify a lid to have a game piece affixed thereto.

Reidinger also offers no motivation to use its disclosure to modify a lid according to the present invention. While Reidinger is directed to coupling a game piece with a cup lid, both the nature of the game piece and Reidinger’s approach to solving the problem are different from that of the present invention. The game pieces in Reidinger are rigid, nonconformable game pieces designed to be separate from both the sealing member and the cup lid. (Reidinger, col. 1, lines 53-56). Such rigid, nonconformable game pieces would be difficult to use with the present invention. Additionally, the game pieces of Reidinger are loose, completely separate articles designed to be contained in a compartment within the lid. Reidinger is not directed to any arrangement where the article itself is affixed to the lid. Thus, there would be no motivation for one skilled in the art to use the teachings of Reidinger to modify a lid as claimed in Applicants’ application.

Johnson further offers no motivation to use its disclosure to modify a lid according to the present invention. Like Strange, there is no disclosure or suggestion anywhere in Johnson that a game piece may be used in connection with the disclosed lid. Additionally, like Reidinger, Johnson is directed to containing a loose, completely separate article in a compartment within the lid, and not to an arrangement where the article itself is affixed to the lid. Thus, there would be no motivation for one skilled in the art to use the teachings of Johnson to modify a lid to have a game piece affixed thereto.

Still further, Warden offers no motivation to use its disclosure to modify a lid according to the present invention. Like Strange, there is no disclosure or suggestion anywhere in Warden that a game piece may be used in connection with the disclosed lid. Warden deals with a completely different problem, namely providing a sealed lid to prevent spilling which can later be opened to create a drink-through lid for consumption by a consumer. (Warden, col. 1, lines

46-52). Thus, there would be no motivation for one skilled in the art to use the teachings of Warden to modify a lid to have a game piece affixed thereto.

Accordingly, Strange, Reidinger, Johnson, and Warden provide no motivation or incentive to modify or combine their teachings, in any combination, to render the claimed invention obvious. Indeed, the Examiner has pointed to no such motivation or teaching in Strange, Reidinger, Johnson, or Warden. The Examiner states in paragraph 11 of the Office Action that the required motivations are provided in the rejections (paragraphs 8-10). In paragraph 8, the Examiner asserts that there is a motivation to combine Strange and Reidinger, "in order to promote the selling of the product." In paragraph 9, the Examiner asserts that there is a motivation to combine Strange, Reidinger, and Johnson, "in order to provide an instruction for the game piece." In paragraph 10, the Examiner asserts that there is a motivation to combine Warden and Reidinger, "in order to promote the selling of the product." These motivations cited by the Examiner are ambiguous and too general. The Examiner does not explain why the cited motivations would lead one skilled in the art to make the specific combinations cited by the Examiner. "A general incentive does not make obvious a particular result." *In re Deuel*, 51 F.3d 1552, 1559 (Fed. Cir. 1995). Additionally, the asserted "motivations" are merely the Examiner's conclusions and are completely unsupported by the references themselves. Further, the Examiner provides no evidence that her conclusions are supported by knowledge generally available to those skilled in the art.

Instead, the Examiner has simply used the claimed invention as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed device obvious, which is impermissible hindsight analysis. *See In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) ("one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."). Thus, the Examiner has not met the burden to show that the cited references are properly combinable, and the Examiner's obviousness rejections are not proper.

**New Claims**

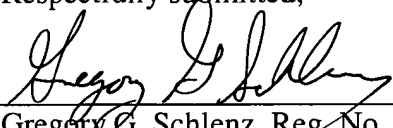
New claim 39 contains elements similar to those discussed above with respect to claims 1, 14, 36, and 37. For example, claim 39 includes the elements, “the outer side wall having a beveled segment extending along a portion of the outer sidewall, wherein the beveled segment is angled with respect to the outer sidewall,” and, “a promotional game piece affixed to the top surface of the plateau around a periphery of the recessed well in spaced relationship to the bottom wall thereof.” Applicants submit that at least these elements of claim 39 are not disclosed by the cited prior art. Thus, Applicants submit that new claim 39 is patentable and in condition for allowance.

Application No. 10/716,869  
Attorney Docket No. 3177 P 526  
Reply to Office Action Mailed March 2, 2006

**CONCLUSION**

In view of the foregoing, Applicants respectfully request reconsideration of the Examiner's rejections and allowance of claims 1-39. Applicants submit that the application is in condition for allowance and respectfully request an early notice of the same. Applicants further request the Examiner to call the undersigned attorney if any issues can be resolved via a telephone interview.

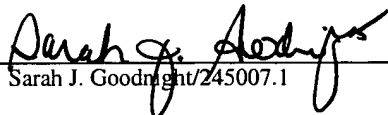
Dated: June 1, 2006

Respectfully submitted,  
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**CERTIFICATE UNDER (37 C.F.R. § 1.8a)**

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 1, 2006.

  
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